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| 09/938,649 | 08/27/2001 | Helen O'Hara | 021058/0257402 | 3549 |
| 909 | 7590 | 12/02/2003 | EXAMINER | |
| PILLSBURY WINTHROP, LLP | | | MILLER, EDWARD A | |
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| MCLEAN, VA 22102 | | | PAPER NUMBER | |

3641

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,649

Applicant(s)

O'HARA ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The previous reply is found non-responsive to Paper No. 11. See 37 CFR 1.111(b and c):

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

However, to avoid delay, final action is taken as follows. Applicants' reply to the rejection was insufficient, which specified Example 50, e.g. Should applicants repeat this, the reply will be held non-responsive, note 37 CFR 1.135, (a-c). Notice of Appeal will not comply with this requirement.

3. In the reply, applicants urge that they have been unfairly handicapped in preparing their response. This is unpersuasive. Binet et al., as further explained below, is in most respects an anticipation of the terms of at least the broad claims. Obviousness is viewed as by the hypothetical person of ordinary skill in the art, as Judge Rich pointed out in *In re Sovish*, 226 USPQ 771, not the absence of ordinary skill. Applicants are charged not only with ordinary skill in the art, but also with a duty of candor to the Office. See the next paragraph.

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4. Claims 60-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binet et al. '184, in view of the notoriously well known art.

In Binet et al. '184, note the teachings generally, and particularly in "Table VII", Example 50. Therein, one finds an example of a gassing solution according to the claimed invention. This must clearly be added to the explosive emulsion, as is notoriously well known in the art.

How else is a gassing solution to provide a sensitization of an emulsion explosive, *without being added thereto*? To allege, as applicants have, that this manner of explanation is deficient and prevents a proper reply, lacks common sense. Further, not only is mixing the sensitizer solution into the emulsion notoriously well known, it is also taught at several places, e.g., in col. 8, lines 15-23. Further, note col. 9, lines 3-25, as well as other teaching found in Binet et al. '184. Indeed, this prior art is not "*indescribable*", as alleged by applicants on page 2 of the reply, it is described in Binet et al. '184. It would be well taken if applicants actually read the reference replied upon, and viewed the teachings from the perspective of one of ordinary skill in the art, not from the lack thereof. The noted teaching of the examiner's stated example, had applicants considered "Example 50," is that the gassing solution itself contains ammonium nitrate, as well as nitrite and thiocyanate accelerator. This is notably set forth in instant claim 60, that one forms a gasser solution which contains "nitrite" and "an ammonium species." As Binet et al. '184 specifically teaches this, what is "*indescribable*"? This is also pointed out in a corresponding Binet et al. reference in the parent, although the US patent is used herein, both with the same "Example 50." It is not well taken for applicants to plead ignorance of matters specifically pointed out in detail in the parent application, when the examiner specifically referred to the prosecution of said parent. Applicants' statements, in context of this prosecution continuing from a basis of the referred to parent, are not well taken.

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Given that the gasser solution is taught, it must perforce, have been “formed”, as required in step “(a)” of claim 60. This, too, is notoriously well known. It is not “*indescribable*”; instead, it is inherent in that a gasser solution is described as it is. It is only ordinary skill in the art, to understand what is specifically set forth in the reference in the subject art. Next, consider the matter of the emulsifier. Said Example 50 includes Emulsifier 1. As applicants note in their reply, the sentence bridging pages 2-3, this emulsifier includes polyalkylene glycol residue of component B. Applicants deny the relevance of this teaching, stating that, “In contrast the presently claimed invention recites a {PIBSA}.” And, indeed, claim 60 recites “a poly[alk(en)yl] succinic based emulsifier” in step “(b),” emphasis added. (Claim 61 includes the same “based” limitation). Applicants’ allegation is incorrect, as col. 5, lines 19-31 especially, and continuing through line 65, clearly teaches that the B component is based on, or obtained by condensation of the PIBSA part with a glycol, as described. It cannot be denied that, contrary to applicants’ assertion, the specific example includes a emulsifier that is based on both a PIBSA part and a polyglycol part, and this is entirely consistent with the language of the claims. In claim 78, the only claim that further limits the emulsifier, one finds that it may comprise an “ester.” As is notoriously well known to a chemist of ordinary skill, an ester is obtained by condensation of an alcohol and an acid (or anhydride), the exact teaching for the “B. Polyesters” from condensing a PIBSA (a substituted succinic anhydride - SA -). Of course, as is also notoriously well known to the chemist of ordinary skill, “ester” is generic to “polyester”. Thus, viewed from the point of view of an artisan of ordinary skill, the prior explanation of the rejection is certainly sufficient, as the essence of the claims is anticipated by the reference.

Considering the next claim 60 limitation, in step “(b)”, the droplets are dispersed throughout the emulsion explosive, which is taught, for example, at col. 3, about lines 33-37. As anticipation is certainly the epitome of obviousness, as to these noted limitations, “Example 50” is at least obvious.

Indeed, Binet et al. '184 may be the epitome of obviousness, anticipation, as to claims broadly presented. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Again, it is inherent that gas bubbles must be formed in the emulsion explosive to effectively sensitize it. If the bubbles are formed prior to the addition to the explosive emulsion, they will escape and fail to serve their taught purpose. Thus, the last limitation of forming the gasser solution just prior to addition to the emulsion explosive is, if not inherent, at least clearly obvious. As this might not be per se taught, the rejection is properly based on 35 USC 103, obviousness.

To the extent necessary, variation of specific notoriously well known ingredients, such as in the prior art applied in the parent application of the instant application, would have been obvious to one of ordinary skill in the art. Further, variation of specific method details would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

As to generating the gas bubble sensitizer, Binet et al. '185 glosses over the chemical mechanism of generating the gas. However, this is well known in the art, and taught, inter alia, in Houston et al. (5,084,117) of record, in col. 1, lines 41-64. This is cited to supported these notoriously well known facts, which applicants have challenged. Notably, the chemical formula and lines 61-62 set forth in detail the "nitrite/ammonium ion" reaction. Also, as set forth therein, the ammonium often originates in ammonium nitrate oxidizer in the explosive. However, as is also taught in Binet et al. '184, Example 50, the ammonium may be added as part of the gasser solution rather than from ammonium nitrate of the explosive emulsion. In a like manner, the general considerations of emulsion explosives, including use of gasser solutions to sensitize such emulsion explosives are well known in the art, and shown (cumulatively) in the prior art in the parent

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application. It is believed that the pH claimed in claims 62-63, e.g., is inherent in Example 50, as is the claim 64 limitation. In any event, variation of amounts, density, pH, etc., would have been obvious to one of ordinary skill in the art, as result effective variables, as set forth in the rejection of record in Paper No. 11. To the extent that claim 69 recites in situ formation of the ammonium ion, this is by migration from the ammonium nitrate in the emulsion explosive from the ammonium nitrate, e.g., the usual way the reaction is carried out in the examples with gasser solutions, other than in Example 50 (also with ammonium nitrate in Example 37). Of course, this is the reaction that applicants urges degrades the polymeric emulsifier, in the last sentence of the Abstract.

Also, see MPEP 716.01(c), and 2145 referred to:

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See MPEP § 2145 generally for case law pertinent to the consideration of applicant's rebuttal arguments.

5. The benefit of the parent foreign priority is denied. Applicants in their reply did not mention at all the requirement of US law regarding that for the benefit to be granted, the invention must be disclosed in accordance with the requirements of 35 USC 112. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance*

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Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Applicants continue to ignore the 35 USC 112 1st paragraph disclosure (e.g.) requirement of 35 USC 119 and 120.

Further, the first paragraph of the specification lacks a reference to the PCT. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. This application was filed subsequent to the effective date for this requirement, Nov. 29, 2000, and the required reference was not made within the 4 months time period specified in the rule. The previously submitted substitute specification was not entered as not complying with the rules, e.g., as to the marked up version. However, the new claims were entered.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
November 27, 2003



EDWARD A. MILLER
PRIMARY EXAMINER